

### REMARKS

Applicants acknowledge receipt of the Office Action dated January 11, 2007, in which the Examiner entered a Restriction Requirement for original Claims 1-72. The Restriction Groups were set out as follows:

**Group I.** Claims 1-41 drawn to a method for making a stabilized transition alumina catalyst support;

**Group II.** Claims 42-69 drawn to a method for making a catalyst; and

**Group III.** Claims 70-72 drawn to a process for making hydrocarbons.

#### Status of the Claims

By this reply, Claims 2-19 and 71-72 are now canceled. Claims 42 and 70 have been amended. Claims 73-92 are new. No new matter was added by way of claim amendments and new claims.

Claims 1, 20-70 and 73-92 are now pending.

#### Election with Traverse

In this response, Applicants elect Group II (i.e., Claims 42-69) *with traverse*. Applicants reserve the right to prosecute the non-elected claims of Group I (i.e., Claims 1-41) and of Group III (i.e., Claims 70-72) by filing one or more divisional applications.

#### No serious burden in search and examination and presentation of linking claims

To support the appropriateness of the restriction, the Examiner states that the inventions of Groups I, II and III are distinct because they have different effects, and that there would be a serious burden on the Examiner if restriction is not required, because the inventions have a separate status in the art as shown by their different classifications.

Applicants respectfully disagree with the restriction, for Applicants do not believe that there is a serious burden of search as required by **MPEP § 803** (see below).

“[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.” **MPEP § 803**

To highlight the interrelation of searches and examination between these groups of claims, Applicants amended independent Claim 42 of elected Group II which now links Group II to the

invention of Group I in accordance with MPEP §809. Indeed, Applicants have amended independent Claim 42 by modifying the preamble from a '*method for preparing a Fischer-Tropsch catalyst*' to a '*method for making a stabilized transition alumina catalyst support and preparing a Fischer-Tropsch catalyst supported on said stabilized transition alumina catalyst support*'. Furthermore, Applicants added to Claim 42 the method steps for making a stabilized transition alumina catalyst support, the steps including steaming, incorporating the structural stabilizer and calcining, to cover the embodiments covered by the independent method Claims 1 and 20 of non-elected Group I. Such amendment is supported by the application as filed, for example by at least original filed paragraphs [0021] and [0022]. As such, the search for Group II and Group I should include the search of the classification 423/625.

In addition, Applicants have cancelled non-elected Claims 71-72 (of non-elected Group III) without prejudice in order to make room for two new Claims 73 and 74 dependent from independent Claim 42 (of elected Group II). The new Claims 73 and 74 now link the method of making the support and the catalyst supported thereon to the process of use of the catalyst represented by the invention of Group III. Support for these new claims is shown below under the New Claims section. It should be noted that either or both of Claims 71-72 may be reintroduced as new claims dependent from Claim 70 in the event that Group III is rejoined to the examination of the present application.

Applicants have further cancelled non-elected Claim 2-19 of non-elected Group I (which were dependent from Claim 1) without prejudice in order to make room for new dependent Claims 75-92 which are now dependent from independent Claim 42 (of elected Group II), in order to cover embodiments of the elected invention to which Applicants are entitled. Support for these new claims is shown below under the New Claims section. However, it should be noted that some or all of the canceled Claims 2-19 may be reintroduced as new claims dependent from Claim 1 in the event that Group I is rejoined to the examination of the present application.

Claim 70 (of non-elected Group III) was also amended to require the same limitations in terms of the method of making the stabilized alumina catalyst support as in currently-amended Claim 42. Claim 70 representing the non-elected invention of Group III is identified as Withdrawn in the Claim Amendment.

Pending Claims 1, 20-41 representing the non-elected invention of Group I are identified as Withdrawn in the Claim Amendment, and they have not been amended.

Thus, in view of the amendment to Claim 42 to link Group II to Group I, and addition of Claims 73 and 74 to link Group II to Group III, as well as and addition of Claims 75-92 to cover additional embodiments to Claim 42, **Applicants respectfully request that Claims 73-92 be prosecuted in this application with the elected Group II and that the elected Group II be redrawn to include Claims 42-69 and 73-92.**

Applicants believe that Claim 42 and its dependent Claims 43-69 and 73-92 of elected Group II are patentable, and respectfully solicit their allowance.

Delay in restriction is prejudicial to timely examination and patent term of the non-elected inventions.

In addition to the lack of burden of search and the presence of linking claims, Applicants advance another reason to disagree with the restriction due to its ill-timed and tardy request. *The Restriction Requirement dated January 11, 2007 was the first notification to Applicants under 35 U.S.C. § 132 in the examination of the present application, and it was mailed more than three (3) years after its filing date under 35 U.S.C. § 111(a).* Applicants did not bring about such delay, as the fee for the examination of the 72 original claims was timely paid, and there were no actions by the Applicants which resulted in delaying the examination.

As a result of this extensive delay in restricting the present case, **Applicants did not have a reasonable opportunity to file a divisional application claiming priority from the present application which has been pending for more than three years.** The USPTO delay in the present application *de facto* causes a delay in the examination of any divisional application which could be filed. Moreover, such delay will have a negative impact on the patent term of a patent granted on a divisional application filed. In this case, the patent term of a patent granted on a divisional application of the present application would be shortened without merit to less than 17 years, even with expeditious processing of the divisional application

Even though a patent granted on a divisional application whose term ends twenty years from the 35 U.S.C. § 111(a) filing date of the parent application can have its term adjusted under 37 CFR 1.702 based on delays *during its own examination*, it is believed that there is no provision in the Patent Laws, Rules and Practice for a patent granted from a divisional application to benefit from extension of term because USPTO failed to make a timely restriction requirement in the parent

**application within fourteen months of its filing date.** That is to say, the USPTO delay from the 14-month period after filing of the parent application to the date of the Restriction Requirement is not carried over to adjust the term of a patent granted from any divisional application filed after the Restriction Requirement. As such, **Applicants are provided with no recourse to recover this time delay by request of an extension of patent term for a patent resulting from a divisional application.**

As such, Applicants believe that the USPTO extensive delay in restricting the present application after more than 3 years after its filing date is prejudicial to the timely examination of the non-elected claimed inventions in a divisional application and also to the patent term of any patent resulting from a divisional application filed after the restriction. On the other end, if the non-elected claimed inventions of Groups I and III are allowed to be examined in the present application, the delay in the examination will be taken into account in the patent term of the granted patent.

For at least the reasons mentioned above, Applicants respectfully request the withdrawal of the Restriction Requirement for the concurrent examination of all inventions represented by Groups I, II and III in the present application.

#### **New Claims**

Applicants added a total number of 20 claims in this Response (i.e., Claims 73-92), each dependent from Claim 42, to add embodiments of the elected Group II to which Applicants are entitled. Applicants submit that each new claim is supported by the application as filed, as follows:

- Claim 73 supported by at least original Claim 71;
- Claim 74 supported by at least original Claim 72;
- Claim 75 supported by at least original Claims 2 and 21;
- Claim 76 supported by at least original Claims 3 and 22;
- Claim 77 supported by at least original Claims 4 and 23;
- Claim 78 supported by at least original Claims 5 and 24;
- Claim 79 supported by at least original Claims 6 and 31;
- Claim 80 supported by at least original Claims 7 and 32;
- Claim 81 supported by at least original Claims 8 and 33;
- Claim 82 supported by at least original Claims 9 and 35;

- Claim 83 supported by at least original Claims 10 and 36;
- Claim 84 supported by at least original Claims 11 and 37;
- Claim 85 supported by at least original Claims 12 and 34;
- Claim 86 supported by at least original Claims 13 and 38;
- Claim 87 supported by at least original Claims 14 and 25;
- Claim 88 supported by at least original Claims 15 and 26;
- Claim 89 supported by at least original Claims 16 and 27;
- Claim 90 supported by at least original Claims 17 and 28;
- Claim 91 supported by at least original Claims 18 and 40; and
- Claim 92 supported by at least original Claims 19 and 41.

#### **Amendments to the Specification**

Paragraphs [0016], [0030], [0082], [0085] of the specification as filed have been amended to correct obvious typographical and/or grammatical errors. Paragraph [0088] has been amended to include serial numbers of patent applications and patent numbers that were not available at the time the application was filed. No new matter was added by way of these amendments.

#### **Conclusion**

Applicants believe that they have fully responded to the Office Action dated January 11, 2007. Applicants further believe that no new matter was added by way of amendments to the specification, amendment to the claims, and addition of new claims. If resolution of any remaining issues pertaining to restriction groups and election may be facilitated by a telephone conference, or if the Examiner has any questions or comments or otherwise feels it would be advantageous, he is encouraged to telephone the undersigned at (281) 293-4751.

Applicants further believe that the cancellation of 20 claims (i.e., Claims 2-19 & 71-72) in this Response is sufficient to cover the addition of 20 new claims (i.e. Claims 73-92) so that no additional claim fee is required.

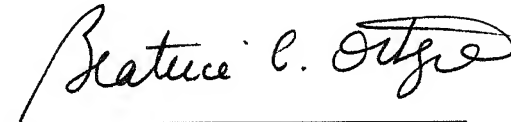
Applicants believe that this response is timely filed within the 31-day shortened statutory deadline set forth in the Office Action dated January 11, 2007, and that no fee is due. However, if any required fee has been inadvertently omitted or any fee has been overpaid, or in the event that an

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extension of time is necessary in order for this submission to be considered timely filed, the Commissioner is authorized to please appropriately charge or credit those fees to **Deposit Account Number 16-1575** and consider this a petition for any necessary extension of time.

Respectfully submitted,

CONOCOPHILLIPS COMPANY - IP LEGAL



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